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May 22, 2006

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Re: Application of: Waters et al.
Serial No.: 09/827,291
Filed: April 5, 2001
For: System and Method for Implementing Financial
Transactions Using Biometric Keyed Data
Group Art Unit: 3621
Confirmation No. 5721
Examiner: Kambiz Abdi
MMB Docket No.: 1001-0724
NCR Docket No. 9385

TRANSMITTAL OF REPLY BRIEF

Please find for filing in connection with the above patent application the following documents:

1. Reply Brief (7 pages); and
2. One (1) return post card.

Commissioner for Patents
May 22, 2006
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Applicants believe no fee is required for filing of this Reply. However, please charge any fee deficiency or credit any overpayment to Deposit Account No. 13-0014.

Respectfully Submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, appearing to read 'James D. Wood', written over a horizontal line.

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May 22, 2006

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

A. IDENTIFICATION PAGE

NCR Docket No. 9385

MMB Docket No. 1001-0724

Confirmation No.: 5721

Application of: Waters, et al.

Group Art Unit: 3621

Serial No. 09/827,291

Examiner: Kambiz Abdi

Filed: April 5, 2001

For: **SYSTEM AND METHOD FOR IMPLEMENTING FINANCIAL
TRANSACTIONS USING BIOMETRIC KEYED DATA**

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REPLY BRIEF

Mail Stop Appeal Brief - Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a reply submitted in response to the Examiner's Answer dated April 21,
2006.

B. STATUS OF THE CLAIMS

Claims 1-4, 6-11 and 13-17 are pending in the application.

Claims 5 and 12 have been canceled.

Claims 1-4, 6-11 and 13-17 are finally rejected.

Claims 1-4, 6-11 and 13-17 are being appealed, and are shown in the Appendix attached to the Amended Appeal Brief.

C. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 6-11 and 13-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,662,166 B2 to Pare, Jr. et al. (hereinafter “Pare”) in view of U.S. Patent No. 6,202,151 B1 to Musgrave et al. (hereinafter “Musgrave”).

D. Argument

The arguments set forth in the Amended Appeal Brief still apply. Furthermore, the Applicant respectfully submits that contrary to the Examiner's assertion, the limitations set forth in the claims should not be dismissed as merely reciting an intended purpose. When the claim elements are given proper weight, the prior art cited by the Examiner does not disclose the claimed invention.

1. The Examiner's Position is Contrary to Precedent

The Examiner has based his rejection on the premise that Pare discloses the use of biometric data in the manner set forth in the Applicants' claims. To support this determination, the Examiner has ignored language in the claims. The Examiner's asserted basis for disregarding the claim limitations is that "the process of identifying or retrieving a financial account data record form (sic) captured biometric data is only an intended use of such information captured by the system." (Examiner's Answer at paragraph 15). The Examiner did not identify any facts that guided his determination. Thus, the Examiner's position is that language of intended use cannot be given patentable weight. The Examiner's position is contrary to law.

Specifically, the Federal Circuit has stated that [w]hether a preamble of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole. *In re Stencel*, 828 F.2d 751, 754, 4 U.S.P.Q.2D (BNA) 1071, 1073 (Fed. Cir.

1987)(citations omitted).¹ Therefore, the Examiner's position is contrary to established precedent.

2. The Clause at Issue is a Limitation

Directing this discussion to the language found in claim 1, the language which the Examiner alleges to merely recite "intended purpose" is "a database server for generating a data storage key from the consumer biometric data." The generation of a data storage key is not merely laudatory language stating the result of the claimed system. Therefore, the clause must be considered when determining the patentability of the Applicants' invention.

Specifically, in analyzing the nature of claim language, the Federal Circuit has affirmed resort to the manner in which the claim element is described in the rest of the specification as the appropriate "facts" to be considered. See, e.g., *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1330, 74 USPQ2d 1481, 1484 (Fed. Cir. 2005). The Applicants' specification identifies the invention as directed to the implementation of financial transactions using biometric data. (Applicants' specification at page 1, lines 2-4). The summary of the invention identifies the method of the invention as including "generating a data storage key from a set of biometric data corresponding to a consumer." (Applicants' specification at page 4, lines 18-20). The summary of the invention further identifies an inventive system as including "a database server for generating a data storage key from the consumer biometric data." Additionally, the database server

¹ The court further noted that the intended purpose could alternatively be set forth in the body of the claim. *Id.*

“retrieves the data record stored in the database by using a data storage key generated from the captured biometric data.” (Applicants’ specification at page 5, lines 21-23).

Therefore, when the facts of the Applicants’ specification are properly considered, the clause “for generating a data storage key from the consumer biometric data” is fundamental to the nature of the claimed invention. The Federal Circuit has stated that when a clause “states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Hoffer*, 405 F.3d at 1329, 74 USPQ2d at 1483.² Accordingly, the clause “for generating a data storage key from the consumer biometric data” is not merely an intended use. Rather, the clause “for generating a data storage key from the consumer biometric data” must be considered in determining the patentability of the claimed invention.

Accordingly, because Pare does not disclose generating a data storage key using captured biometric data as claimed, the Applicants’ invention is patentable over the cited art as discussed more fully in the Amended Appeal Brief.

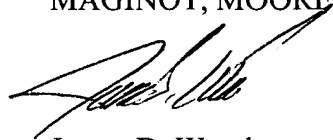
² The *Hoffer* case dealt with claim interpretation in the context of an infringement case. Nonetheless, while greater breadth is afforded terms within the context of the examination of a claim, such an approach cannot expand the breadth of the term to the point whereat the claim is no longer limited by the term. Therefore, the approach affirmed by the *Hoffer* court is appropriate for use during the examination of a claim.

3. Conclusion

For the reasons set forth in the Amended Appeal Brief and for the reasons set forth above, claims 1-4, 6-11 and 13-17 are not unpatentable over Pare in view of Musgrave. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 1-4, 6-11 and 13-17.

Respectfully submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, appearing to read 'James D. Wood', is written over the firm name.

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May 22, 2006

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